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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,906	10/30/2003	Charles D. Powell	006394.00003	9238

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GABLE & GOTWALS  
100 WEST FIFTH STREET, 10TH FLOOR  
TULSA, OK 74103

EXAMINER
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ROWAN, KURT C

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/696,906

Applicant(s)

POWELL, CHARLES D.

Examiner

Kurt Rowan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-20 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 20 is objected to because of the following informalities: claim 20 does not end in a ".". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7, 15, 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caccamo in view of Sugimoto.

The patents to Caccamo and Sugimoto show decoys. Caccamo shows one or more support arms 14 attached to a platform P such that the support arms are positioned above the platform P. Caccamo shows a waterfowl decoy D attached to the upper end of the support arms with the decoy positioned above the platform. The patent to Sugimoto shows a decoy 1 mounted on a cable 3 which is attached to a rotatable platform or body 6. Sugimoto shows a force-generating unit 5 for rotating the platform and a power source such as an electric motor (see column 4, lines 61-64). In reference to claims 1, 2 and 16, it would have been obvious to provide the decoy of Caccamo with a rotating platform, a force generating unit and a power source as shown by Sugimoto for the purpose of rotating the decoys in a circle to attract more waterfowl at times when

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wind and water power is not providing enough power. In reference to claim 3, Caccamo as modified by Sugimoto does not disclose a jet propulsion device, but it would have been obvious to employ an alternate propulsion system such as a jet since the function is the same and no stated problem is solved. In reference to claim 4, Sugimoto discloses electric power, but does not disclose a battery. However, it would have been obvious to employ an old and well known battery power source to operate the unit in areas with no AC power. In reference to claim 5, Caccamo discloses flexible arms having a rectangular shape as shown in Fig. 13. However, Sugimoto discloses wire 3 which is taken to be round. In reference to claim 6, Caccamo discloses a flexible arm in column 2, lines 58-60. In reference to claims 7 and 17, Caccamo discloses a decoy with a body portion and wings spread apart as shown in Figs. 1-2. In reference to claim 15, Sugimoto discloses a controller in column 3, lines 11 and 19-22.

3. Claims 8-14 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caccamo as modified by Sugimoto as applied to claim 1 above, and further in view of Porter.

The patents to Caccamo and Sugimoto show decoys and have been discussed above. Porter shows a decoy mounted on a buoyant housing 9 which the decoy 20 is mounted to. In reference to claims 8, 18, 19, it would have been obvious to mount the decoy and housing of Caccamo as modified by Sugimoto on a buoyant housing as shown by Porter to use the unit in water too deep to sink a pipe into the ground. In reference to claim 9, Sugimoto shows a rotatable platform 6 rigidly attached to the housing 4. In reference to claims 10 and 20, Porter discloses a buoyant housing 9 with a flotation

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device as disclosed in paragraph number 45. In reference to claim 11, Porter shows hydrodynamic drag inducing elements such as Styrofoam pads attached to an outer surface of the buoyant housing. In reference to claims 12 -14, the proposed combination does not recite that the power supply is located within the buoyant housing or attached to an outer surface, but it would have been obvious to locate the power supply in the housing or on the outer surface of the housing to provide access for service options.

4. Claims 1-7, 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugimoto in view of Caccamo.

The patents to Sugimoto and Caccamo show movable decoys as discussed above. In reference to claims 1, 16, it would have been obvious to provide the decoy of Sugimoto with arms extending above the platform as shown by Caccamo for the purpose of using the device in locations where a top mount is not practical by mounting the rotatable platform and box from the bottom. In reference to claims 2-7, 15, 17, see the rejection of these claims above, now Sugimoto in view of Caccamo.

5. Claims 8-14, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugimoto in view of Caccamo as applied to claim 1 above, and further in view of Porter.

The patents to Sugimoto, Caccamo and Porter show movable decoys as discussed above, but do not show a buoyant housing which is shown by Porter. In reference to claim 8, 18, 19, it would have been obvious to provide the decoy of Sugimoto as modified by Caccamo with a floating platform as shown by Porter for the purpose of

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using the decoys in water too deep to drive a pole into the bottom. In reference to claims 9-14, 20, see the rejections of these claims above, now Sugimoto in view of Caccamo and further in view of Porter.

### ***Response to Arguments***

6. Applicant's arguments filed Oct. 22, 2004 have been fully considered but they are not persuasive. Applicant is urged to take care of the objection to claim 20 to avoid an amendment being held non-responsive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As to the combination of Caccamo and Sugimoto no longer being simple, patentability is not determined on simplicity. The argument that Caccamo would not longer be powered by the wind and using a computer controlled motor would be antithetical to the teachings of Caccamo also is not correct since the correct test of the combination is what is suggested as a whole to one of ordinary skill in the art. In response to applicant's argument that how can the flexible arm and decoy of Caccamo be incorporated into Sugimoto, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge is generally available to one of ordinary skill in the art. Applicant argues that one reference attracts birds and the other reference scares birds and hence have different solutions to different problems, but it should be pointed out that a bird scaring device might scare some birds but attract other birds such as birds of prey. Also, making the decoy fly at a greater height with respect to the motor or housing would be an obvious manner of design choice since the rearrangement of the location of parts is obvious. See *In re Japikse*, 86 USPQ 70. It should be pointed out that Caccamo shows the decoys in Fig. 1 being located above pipe P which would correspond to a central housing. In reference to claim 19, Porter shows a buoyant housing and it would have been obvious to mount the force generating unit of Sugimoto on it for use in a water environment to keep the electrical components such as the motor, battery, and connection dry. It should be pointed out that Porter is cited simply to show a buoyant housing.

### ***Conclusion***

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7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Rowan whose telephone number is 703 308-2321. The examiner can normally be reached on Monday-Thursday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on 703 308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Kurt Rowan", with a checkmark at the end.

Kurt Rowan  
Primary Examiner  
Art Unit 3643

KR